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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,833	02/27/2004	Dewayne Turner	020569-05007	6924

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,833

Applicant(s)

TURNER ET AL. *gr*

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 23-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 23-26 is/are allowed.
- 6) ☒ Claim(s) 27-30,37-43 and 46-49 is/are rejected.
- 7) ☒ Claim(s) 31-36,44,45 and 50-54 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The Preliminary Amendments filed 27 February 2004, 01 October 2004, and 22 November 2004 have been entered and considered with the Office Action below.

Drawings

1. The drawings are objected to because the following figures do not include any reference numbers which are required for complete understanding of the claimed invention: 5A, 6A, 5E, 6E, 11C, and 12 G. Reference numbers should be added to the figures and, if not already found in the specification, added to the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because of the following informalities: Figures 5A-5E and 6A-6E are objected to because it appears that two drawing labels have been given to one figure, i.e. Figure 5A and 6A are the same figure. The examiner recognizes that applicant is attempting to show the different positions of the claimed invention but notes that each figure should be labeled as only one figure showing the change in position.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified

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and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because the abstract does not adequately describe the claimed invention as the claims are drawn toward a pressure actuated valve and a tool shiftable valve. Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

6. The disclosure is objected to because of the following informalities: the Cross-reference Application data should be updated to include the patent number of the parent application.

Appropriate correction is required.

Claim Objections

7. Claims 32, 37, and 45 are objected to because of the following informalities:
- Claim 32 is objected to because it is the opinion of the examiner that applicant intended the claim to depend from claim 27 and is treating it as such for the purposes of examination.
 - Claim 37 recites the limitation "the production screen" in line 1. There is insufficient antecedent basis for this limitation in the claim.
 - Claim 45 is objected to because it is the opinion of the examiner that applicant intended the claim to depend from claim 44 and is treating it as such for the purposes of examination.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

-
9. Claims 27-30, 37-43, and 46-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilsman, III (US 4,940,093).

Regarding claim 27: Hilsman discloses an isolation system that includes the following features:

- An isolation pipe (Figures 6 and 7).
- A pressure activated valve 60 coupled to the pipe.
- A tool shiftable valve 244 (the examiner notes that this element is noted as reference character "44" in the specification but appears to the labeled "244" in Figures 6 and 7) coupled to the pipe and in communication with the pressure activated valve.

Regarding claim 28: The tool shiftable valve is a sliding sleeve that is movable between an open and closed position.

Regarding claims 29, 40, 47, 48: The system, and the sleeve, is inserted into the well to allow a gravel packing operation to occur before closing the sleeve and opening the pressure activated valve.

Regarding claim 30: The pipe includes a port 240 through which fluid flows when the sleeve is in the open position.

Regarding claim 37: Though not specifically disclosed, the system would inherently include a screen as this is well known feature of a gravel packing system.

Regarding claims 38, 41: Hilsman further discloses a method for using the above system. The method involves the following steps:

- Inserting the system into the wellbore.
- Shifting the sleeve.
- Opening the pressure activated valve through the use of pressurized fluid.

Regarding claim 39: The opening of the pressure activated valve occurs while the sleeve is in the wellbore.

Regarding claim 43: The system allows production fluid to flow through the valves.

Regarding claims 43, 49: The tool shiftable valve is moved using a shifting tool (6:55-67), which is removed after the sleeve longer, needs to be moved.

Regarding claim 46: Hilsman further discloses a method for using the above system. The method involves the following steps:

- Inserting the system into the wellbore.
- Setting the system in the wellbore adjacent perforations.
- Shifting the sleeve.
- Opening the pressure activated valve through the use of pressurized fluid.
- Producing fluid through tubing in the wellbore.

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Allowable Subject Matter

10. Claims 1 and 23-26 are allowed.
11. Claims 31-36, 44, 45, and 50-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining references made of record disclose various wellbore valve and valve systems.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer H Gay
Patent Examiner
Art Unit 3672

JHG 
December 20, 2004